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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,335	03/09/2000	Birgit Oppmann	DX0935K	2729

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DNAX RESEARCH, INC.  
LEGAL DEPARTMENT  
901 CALIFORNIA AVENUE  
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EXAMINER

HAYES, ROBERT CLINTON

ART UNIT PAPER NUMBER

1647

13

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/521,335

Applicant(s)

Oppmann et al

Examiner

Robert C. Hayes, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 27, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16, 21, and 23-40 is/are pending in the application.
- 4a) Of the above, claim(s) 1-16, 21, and 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-37 and 39 is/are rejected.
- 7) ☒ Claim(s) 38 and 40 is/are objected to.
- 8) ☒ Claims 1-16, 21, and 23-40 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group VI (claims 17-20 & 22 b-c; as it relates to the human polynucleotides encoding SEQ ID NO:2 & 12) in Paper Nos: 8 & 12 is acknowledged. The traversal is on the ground(s) that "no serious search burden would exist to examine the claims of Group VI and Claims 23-25". This is not found persuasive because a serious search burden does exist for searching different sequences which are otherwise unique, as exemplified by their unique SEQ ID Nos; especially as it relates to searching combinations of two SEQ ID Nos: together, and for the reasons made of record. Thus, the non-coextensiveness of the search and examination for each group would constitute an undue burden on the examiner to search and consider all the separable groups with their recognized divergent subject matter. The requirement is still deemed proper and is therefore made FINAL.

Claims 1-16, 21, 23-30 and part of claim 36 (i.e., as it relates to nonelected SEQ ID NO: 3) are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions, the requirement having been traversed in Paper No. 8.

The requirement is still deemed proper and is therefore made FINAL.

This application contains claims 1-16, 21, 23-30 & 36 (as it relates to SEQ ID NO:3) are drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

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***Allowable Subject Matter***

2. Claims 38 & 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 U.S.C. § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 34 & 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For example, the current recitation of "A host cell" encompasses a human organism. It is suggested that amending these claims to "an isolated host cell" should obviate this rejection.

***Claim Rejections - 35 U.S.C. § 112***

4. Claims 31-36 & 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is ambiguous what exactly is envisioned by the current claim language for the nucleic acid of claim 31. As currently claimed, both SEQ ID NO:2 and 12 are encoded by the same

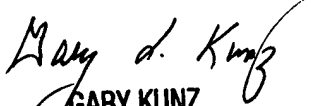
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nucleic acid molecule. If so, how is it envisioned that a soluble heterodimer complex is made with both proteins fused to each other? Moreover, if both nucleic acids encoding SEQ ID NO:2 & 12 are actually one nucleic molecule, such a nucleic acid would not be in compliance with the SEQUENCE RULES because 37 CFR 1.822(o) states that a sequence made up of *one or more noncontiguous segments* of a larger sequence *or segments from different sequences* shall be presented as a separate sequence. Alternatively, these nucleic acids are not currently recited to be under the control of two different expression vector sequences within the same vector.

In either case, dependent claim 36 makes no sense, as currently claimed, because only SEQ ID NO:1 is claimed, yet both IL-B60 and CLF-1 are required to be encoded in base claim 31; and they are not both encoded by SEQ ID NO:1. The claims are, therefore, indefinite.

***Information Disclosure Statement***

5. The information disclosure statement filed 9/6/00 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered for those references cross out.

  
GARY KUNZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

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*Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Thursday, and alternate Fridays, from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to be 'RCH', is written above the printed name of Robert C. Hayes.

Robert C. Hayes, Ph.D.

March 28, 2003